



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,839	06/30/2000	Michael A. Cleron	14531.70	2344

22913 7590 02/03/2004

WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER &
SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER

DENNISON, JERRY B

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,839

Applicant(s)

CLERON ET AL.

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 16-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This application has been examined.
2. Claims 1-15 and 27-33 are presented for examination

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 9-15 and 27-33 are rejected under 35 U.S.C. 102(b) as being unpatentable over Haverstock et al. (U.S. Patent Number 6,678,738) hereinafter referred to by Haverstock.
4. Regarding claims 1, 9, 12, 13, 27, 30, and 31, Haverstock discloses in a server included in a network that also includes a client associated with specified attributes, a method of using a decision engine to create a document for use by the client, the document being customized according to the specified attributes associated with the client, the method comprising the acts of:
processing code associated with a script at the server, including code that, when executed, requests the decision engine to select content for the document based on at least one attribute of the client, and without specifying either the at least one attribute of the client or how the selection of content is to be made (col. 3, lines 53-59, Haverstock teaches a server receiving an attribute from a user, a URL-based request, the attribute being passed to a module, or decision

engine, and the module selecting content for the document based from the user's attribute, without specifying the user's attribute);

receiving from the decision engine an identification of the content that has been selected by the decision engine (col. 3, lines 60-61, Haverstock teaches a non-HTML server module receiving a request for information from the interface module, or decision engine);

creating the document and incorporating into the document the content that has been selected by the decision engine (col. 3, lines 61-65, Haverstock teaches an HTML translator within the decision engine, incorporating the content into the HTML document being passed back to the user); and

transmitting the document to the client (col. 3, lines 64-65, Haverstock teaches the document being transmitted back to the user).

5. Regarding claims 2, 10, 11, 14, 15, 28, 29, 32, and 33, Haverstock discloses the features of the invention, substantially as claimed, as described in claim 1, including wherein the act of receiving the identification of the content comprises the act of receiving additional script that, when executed, results in being incorporated into the document (col. 5, lines 29-47, Haverstock teaches wherein receiving the identification of the content, and the content being non-HTML, objects 18a-18n, additional script is used to request the information through non-HTML, and additional script is used to translate the non-HTML into an HTML representation, and then combine the HTML representation with the HTML objects 50a-50n).

6. Regarding claim 3, Haverstock discloses the features of the invention, substantially as claimed, as described in claim 2, including the act of assembling the script at runtime by concatenating said portion of script and said additional script (col. 5, lines 13-27, Haverstock

teaches at runtime, if the user requests non-HTML objects to be displayed with HTML objects, the system translates the non-HTML into an HTML representation and combines this representation into the HTML object).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 1 and 4-8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Cottrille et al. (hereinafter "Cottrille," "6,581,096").

9. Regarding claim 1, Cottrille discloses in a server included in a network that also includes a client associated with specified attributes, a method of using a decision engine (server) to create a document for use by the client, the document being customized according to the specified attributes associated with the client, the method comprising the acts of:

processing code associated with a script at the server, including code that, when executed, requests the decision engine to select content for the document based on at least one attribute of the client (col. 5, line 65 through col.6 line 12, Cottrille teaches of a community server that dynamically assembles community elements into an HTML document when a request from a client in that community is received.);

receiving from the decision engine an identification of the content that has been selected by the decision engine(col. 5 lines 31-37, Cottrille teaches of a server which allows a user access to community elements based on the user's identity.);

creating the document and incorporating into the document the content that has been selected by the decision engine(col. 5, line 65 through col.6 line 12, Cottrille teaches of a community server that dynamically creates an HTML page containing requested content when a request from a client is received.); and

transmitting the document to the client (col. 6 lines 5-19, Cottrille teaches of a community server which returns the assembled elements to the client in the form of a web page.)

10. Regarding claim 4, Cottrille discloses the features of the invention, substantially as claimed, as described in claim 1, including wherein:

the act of processing code associated with the script is performed by a server application operating at the server (col. 5, line 65 through col.6 line 12, Cottrille teaches of a community server that dynamically assembles community elements into an HTML document at runtime.); and

requesting the decision engine to select content for the document based on attributes of the client is conducted without the server application communicating to the decision engine a value of said at least one attribute of the client (col. 6 lines 8-12, Cottrille teaches a server (decision engine) to create a community web page containing the client's community elements based on the client's user id.).

11. Regarding claim 5, Cottrille discloses the features of the invention, substantially as claimed, as described in claim 4, including wherein requesting the decision engine to select content for the document based on attributes of the client is further conducted without the server application communicating to the decision engine criteria by which the decision engine is to select the content (col. 6 lines 8-12, Cottrille teaches of a server which runs code that dynamically creates a web page containing the client's community elements supplied by the server.).

12. Regarding claim 6, Cottrille discloses the features of the invention, substantially as claimed, as described in claim 1, including wherein the document is a web page (col. 6, lines 14-18, Cottrille teaches of a community server which dynamically creates a web page containing community elements.)

13. Regarding claim 7, Cottrille discloses the features of the invention, substantially as claimed, as described in claim 6, including wherein the content comprises at least one of text and an image that are determined to be appropriate for the client (col. 2, lines 5-6, Cottrille teaches of community elements that include non-real time based messaging which is a form of text.).

14. Regarding claim 8, Cottrille discloses the features of the invention, substantially as claimed, as described in claim 6, including wherein the content comprises formatting that is determined to be appropriate for the client (col. 2, lines 9-15, Cottrille teaches of community management functions enabling users to format their community elements appropriately).

Response to Arguments

15. Applicant's arguments with respect to claims 1-15, and 27-33 filed 12 January 2004 have been fully considered but they are not persuasive. Applicant's arguments include the failure of previously applied art to expressly disclose the teachings of a server requesting a decision engine to select content for a document based on at least one attribute of the client [see Applicant's Response, Paper#8 page 12 of 15] and that the request for a decision engine to select a second portion of the script is made on specified attributes of the client that are identified by the decision engine without the request or script identifying the attributes [see Applicant's Response, Paper#8 page 14 of 15]. It is evident from the mappings found in the above rejection that Haverstock discloses the teaching of a server requesting a decision engine, referred to as an interface module, to select content for a document based on at least one attribute of the client, in the case of Haverstock, the user's HTTP request. Further, it is clear from the numerous teachings (previously and currently cited) that the provision for using "a decision engine" was widely implemented in the networking art.

16. As it is extremely well known in the networking art as already shown by Haverstock and Cottrille as well as other prior arts of records disclosed, servers using decision engines as well as other claimed features of Applicant's invention. Applicant only claims a decision engine within a server to create a customized document based on at least one client attribute. By Haverstock disclosing an interface module within the server, making a decision as to what content is to be

retrieved based from the user's request and that content being incorporated into the document, it is obvious to the examiner that additional scripts must be used to retrieve, translate the content into the proper format, and combine the scripts to produce the final document. Combining scripts based on attributes to produce a document is a common practice by web developers using PHP, an open-source, HTML-embedded scripting language that can be used to develop web applications. An important feature of PHP is the ability to include files, using the include function. This function allows developers to break out common components into separate files and call the include function on these files where they are needed (Lerdorf, PHP Pocket Reference, Section 1.3.1, "Including Files"). PHP also contains control structures, which are used to control the logical flow through a PHP script, for example, the "if" statement causes particular code to be executed if the expression it acts on is true (Lerdorf, PHP Pocket Reference, Section 1.9, "Control Structures"). The existence of a decision engine is inherent in any server where scripts are combined depending on attributes to dynamically produce documents because any code containing a control structure such as an "if" statement can be considered an engine that makes a decision as to what scripts are to be used to produce the final document. Thus, Applicant's arguments drawn toward distinction of the claimed invention and the prior art teachings on this point are not considered persuasive. It is also clear to the Examiner that Haverstock and Cottrille clearly teach the independent claims of the Applicant's claimed invention.

17. Applicant's arguments with respect to claims 1-15 and 27-33 are deemed moot in view of the following new grounds of rejection, necessitated by Applicant's amendment to the claims

(i.e., ...*without specifying either the at least one attribute of the client or how the selection of the content is to be made*) which significantly affected the scope thereof.

18. Furthermore, as it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Cottrille and Haverstock as well as other prior arts of records disclosed, using "a decision engine to select content" is taught as well as other claimed features of Applicant's invention. Applicant only claims the use of a decision engine to select content to create a customized document, which is well known in the art. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

19. It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

20. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry B Dennison whose telephone number is (703)305-8756. The examiner can normally be reached on M-F 8:30am-5pm.

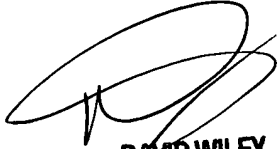
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703)308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Application/Control Number: 09/607,839
Art Unit: 2143

Page 11

JBD
Patent Examiner
Art Unit 2143
December 05, 2003



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100